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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,089	12/17/1999	Keiko Sakakibara	001560-377	1763

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EXAMINER

SWITZER, JULIET CAROLINE

ART UNIT PAPER NUMBER

1634

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/446,089

Applicant(s)

SAKAKIBARA ET AL.

Examiner

Juliet C. Switzer

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 06 May 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 20.

Claim(s) rejected: 1-9, 18-26.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

Continuation of 2. NOTE: (a) The amendments add a number of limitations that require further search and consideration. For example, claim 37 (newly added) introduces sequences that have never been specifically recited in the claims prior to this amendment and whose examination would require further search and consideration.

(b) The amendments to claims 1 and 18 to specifically recite the family "Scrophulariales" raises the issue of new matter.


(c) The amendment does not reduce or simplify the issues of record, but instead compounds them.

(d) The amendment adds 16 new claims and cancels five finally rejected claims.

Continuation of 5. does NOT place the application in condition for allowance because: Many of applicant's arguments are addressed to the claims as amended. Since the amendments were not entered, the arguments are moot. Arguments have been addressed insofar as they address the rejections and claims of record.

With regard to the 112 1<sup>st</sup> paragraph, lack of enablement rejection, applicant argues that undue experimentation would not be required to practice the claimed invention because one skilled in the art would be able to use SEQ ID NO: 1 as a probe to obtain other sequences which could encode proteins having activity to synthesize auronones as claimed. As a first point, attorney's comments are noted to be arguments which are not supported by evidence in the record. Furthermore, the argument does not address the fact that it is highly unpredictable of those nucleic acids which might hybridize to instant SEQ ID NO: 1 which ones would fall within the scope of the instant claims, if any at all would fall within that scope. The specification does not provide any identifying structural characteristics that one could use to identify sequences within the scope of the claims, nor does the specification provide any disclosure as to how instant SEQ ID NO: 1 can be modified yet still retain the claimed functional characteristics. Furthermore applicant's arguments and specification suggests that the claimed genes are polyphenol oxidases, but again, does not disclose how to distinguish within all polyphenol oxidases which ones are within the scope of the claimed invention.

With respect to the written description rejection, applicant argues at page 12 of the response that one would have been enabled to obtain the full length gene encoding SEQ ID NO: 2 via hybridization with SEQ ID NO: 1. Applicants suggest that with regard to written description they merely need to communicate to those skilled in the art that the claimed subject matter is intended to be part of their invention. The examiner disagrees. The court has made it clear that with regard to chemical compounds, the standard for written description is possession, not enablement or intent to claim. "While we have no doubt a person so motivated would be enabled by the specification to make it, this is beside the point for the question is not whether he would be so enabled but whether the specification discloses the compound to him, specifically, as something appellants actually invented. We think it does not." In *Re Ruschig*, 379 F.2d 990, 995, 154 U.S.P.Q. 118, 123 (CCPA 1967). Furthermore, the court stated "Accordingly, naming a type of material generally known to exist, in the absence of knowledge as to what that material consists of, is not a description of that material." *The Regents of the University of California v. Eli Lilly & Co.*, 43 U.S.P.Q.2d 1406 (Federal Circuit 1997). In the instant case, possession of the claimed materials has not been demonstrated.

  
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